REMARKS

In response to the Decision on Request for Rehearing (hereinafter "Decision") of the Board of Patent Appeals and Interferences (hereinafter "Board") mailed August 9, 2006, claims 48-51 and 53-62 have been cancelled without prejudice or disclaimer, and claims 47 and 52 have been amended. No claims have been newly added. Therefore, claims 47 and 52 are pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

In the Decision, the Board vacated the portion of their 02/08/06 Decision on Appeal which held that independent claim 61 failed to comply with 35 U.S.C. § 112, ¶1 [Decision, pg. 2]. The Board still sustained the rejection of claims 47-60 and 62 under 35 U.S.C. § 112, ¶1, however, which alleged that the specification lacks support for the phrases "wherein each coupon may be used *a pre-determined number of times*," and "monitoring redemption of the one or more coupons such that each coupon may be used *a predetermined number of times*" as recited in independent claims 47, 52, 57, & 62 (the "Predetermined Number of Times Recitation") [Decision, pg. 2].

Applicants disagree with the rejection of the Examiner and with the Decision of the Board in sustaining the rejection under 35 U.S.C. § 112, ¶1, and expressly reserve the right to pursue the Predetermined Number of Times Recitation in this application (or in a related application) at a later time. However, *solely* in an effort to expedite prosecution, and without conceding to the propriety of the rejection, the Predetermined Number of Times Recitation has been removed from independent claims 47 and 52, thus broadening one or more of the aforementioned phrases which previously included the Predetermined Number of Times Recitation. The cancellation of claims 48-51, 53-60, and 62 has rendered the rejection of these claims moot. Accordingly, withdrawal of this rejection is earnestly sought.

REJECTION UNDER 35 U.S.C. § 102

In the Decision, the Board designated their sustaining of the rejection of claims 47-62 under 35 U.S.C. § 102(b) (as allegedly being anticipated by U.S. Patent No. 5,227,874 to Von Kohorn) as a new ground of rejection under 37 C.F.R. § 41.50(b):

> Since we basically agreed with appellants that some portions of Von Kohorn relied on by the examiner did not support the examiner's findings, we agree with appellants that fundamental fairness requires that we designate our decision in this case with respect to the anticipation rejection as a new ground of rejection under 37 CFR § 41.50(b).
>
> [Decision, pg. 3].
>
> In summary, we have granted appellants' request for rehearing to the extent...that we have designated our sustaining of the rejection of all claims under 35 U.S.C. § 102(b) as a new ground of rejection under 37 CFR § 41.50(b).
>
> [Decision, pg. 6].

Applicants disagree with the rejection of the Examiner and with the new ground of rejection alleged by the Board. However, *solely* in an effort to expedite prosecution, and without conceding to the propriety of either the original rejection or the new ground of rejection, independent claims 47 and 52 have been amended to clarify various points of novelty over Von Kohorn. The cancellation of claims 48-51 and 53-62 has rendered the rejection of these claims moot.

Independent claims 47 and 52 (as amended) are directed to a method and system, respectively, for providing coupons over the Internet. Nowhere does Von Kohorn disclose an Internet-based method or system. For this reason alone, the rejection of claims 47 and 52 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

Applicants further note, however, that independent claims 47 and 52 also recite, *inter alia*, the feature of:

> ...receiving, at the Internet-accessible location, a request from the user for access to at least some of the stored coupon information, wherein the unique identifier is encrypted and

transmitted with the request, and one or more routines are implemented at the Internet-accessible location to decrypt the unique identifier to ensure validity;

The Board has already determined (in a proceeding in related, co-pending application no. 09/321,597) that this feature is not disclosed by Von Kohorn. *See* Ex Parte Barnett, No. 2006-0535 (B.P.A.I. May 19, 2006) at pg. 19. For *at least* this reason, the rejection of claims 47 and 52 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

Should the Examiner maintain the rejection of independent claims 47 and 52 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,227,874 to Von Kohorn, Applicants expressly reserve the right to argue additional differences between Von Kohorn and the claimed subject matter.

CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that the application is in condition for allowance. Notice to that effect is respectfully requested. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: October 10, 2006

Respectfully submitted,

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